

REMARKS

Applicants have amended claims 1, 8-9, and 14-17, and canceled claims 1-8, 10-13, and 16. with respect to the present patent application. Applicants are not conceding in the present patent application that these claims are not patentable over the art cited by the Examiner, as the claim amendments and cancellations are only for facilitating expeditious prosecution of the patent application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

In a telephonic interview on July 18, 2007 between Examiner Insun Kang and Applicants' Representative Jack P., Friedman, Applicants' proposed amendment of claim 9 was discussed and no agreement was reached. The Examiner's Interview Summary indicates that the date of the interview was July 17, 2007 which Applicants believe to be a clerical error.

The amended language of claim 9 is supported in: the specification, page 8, lines 9-13 (i.e., the voice prompt in the database record is a *bit pattern*); the specification, page 1, lines 13-14 (i.e., an exemplary voice prompt is quoted whose associated bit pattern inherently consists of a *contiguous sequence of bits*); the specification, page 3, lines 12-16 (i.e., the value assigned to the variable in the assignment table *selects* the database record that comprises the voice prompt or bit pattern); and the specification, page 8, lines 5-8 (i.e., value assigned to the variable in the assignment table *specifies* the voice prompt or bit pattern).

New claims 18-19, which recite that an interactive voice response system administrator assigns a second value of the variable and replaces the first value of the variable in the assignment table with the second value of the variable, is supported in the specification, page 4, lines 4-10.

New claim 20, which recites “wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special (IVR) programming skill to replace the first value with the second value”, is supported in the specification, page 3, lines 4-5; page 4, lines 15-17; page 6, lines 9-10.

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

The Examiner rejected claims 11-17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Applicant respectfully traverses the § 102 and § 103 rejections with the following arguments.

35 U.S.C. § 102(b)

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Since claim 10 has been canceled, the rejection of claim 10 under 35 U.S.C. § 102(b) is moot.

Applicant respectfully contends that Osder does not anticipate claim 9, because Osder does not teach each and every feature of claim 9. For example, Osder does not teach the feature:

“identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first contiguous sequence of bits, wherein said identifying the first database record is implemented through use of the first value which selects the first database record and specifies the first bit pattern;

reading the identified first database record;

passing the first bit pattern from the first database record that had been read to an audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus; and

speaking, by the audio apparatus, a first message to a telephone caller, said first message consisting of the digital-to-analog converted first bit pattern.”

As indicated in both the Examiner’s “Response to Arguments” and the decision of the Board of Appeals and Interferences (page 4, line 22 - page 5, line 3) on February 21, 2007, Osder’s voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which

recites: “A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt “you have <number> new messages”, the phrases “you have” and “new messages” are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time.”

Osder does not teach omission of the preceding “assembling step” of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said “assembling step”, it is logically impossible for Osder to teach that the content of the spoken message at runtime consists of the digital-to-analog converted first bit pattern existing in the first database record, as recited in claim 9.

In other words, Osder’s voice prompt that is spoken at runtime is generated by the “assembling step” from two distinct bit patterns located in different database records, namely first bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record.

Based on the preceding arguments, Applicant respectfully maintains that Osder does not anticipate claim 9, and that claim 9 is in condition for allowance.

35 U.S.C. § 103(a)

The Examiner rejected claims 11-17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Since claims 11-13 and 16 have been canceled, the rejection of claims 11-13 and 16 under 35 U.S.C. § 103(a) is moot.

Since claims 14-15 and 17 depend from claim 9, which Applicant has argued *supra* to be patentable under 35 U.S.C. §1029b0 over Osder, Applicants maintain that claims 14-15 and 17 are not unpatentable under 35 U.S.C. §103(a) over Osder.

With respect to claims 14-15, the decision of the Board of Appeals and Interferences (page 7, line 24 - page 8, line 7) on February 21, 2007 recites: “We will sustain the Examiner’s rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).”

In light of the preceding analysis by the Board of Appeals and Interferences, Applicants have restructured the language of claims 14-15 in a manner that the recited attributes of the voice prompts do not merely describe the content of the data stored in the voice prompt database, but actually limit the active method steps of speaking the first message. The language of claim 17 has been similarly restructured, as is the language of new claims 20-24. Applicants respectfully

request that the Examiner review claims 14-15, 17, and 20-24 in light of the restructured claim language.

In addition with respect to claim 14, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music”.

The Examiner argues that “Per claim 14: ... Osder does not explicitly teach that the database includes a voice prompt that includes music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 14. Since it is a legal requirement for the Examiner to show that preceding feature in claim 14 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 14, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how

to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are music.

Therefore, claim 14 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 15, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of an audio tone, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said audio tone”.

The Examiner argues that “Per claim 15: ... Osder does not explicitly teach that the database includes a voice prompt that includes an audio tone. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include audio tone of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art ”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 15. Since it is a legal requirement for the Examiner to show that preceding feature in claim 15 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Moreover, Applicants assert that it is not obvious to modify Osder to include the

preceding feature in claim 15, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are said audio tone.

Therefore, claim 15 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 17, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps”.

The Examiner argues that “Per claim 17: ... Osder does not explicitly teach that the digitally-encoded voice prompt consists f a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants not that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 17. Since it is a legal requirement for the Examiner to

show that preceding feature in claim 17 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 17, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are a sequence of beeps.

Therefore, claim 17 is not unpatentable under 35 U.S.C. §103(a) over Osder.

Additionally, Applicants respectfully request that the Examiner support any prior art rejections of claims 14-15, 17, and 20-24 with references that allegedly teach or suggest the features specific to claims 14-15, 17, and 20-24.

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457 (IBM).

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